



Proc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

06783.P011

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 10, 2005

Signature _____

Typed or printed
nameCheri Clinkenbeard

Application Number

09/814,159

Filed

3/20/01

First Named Inventor

John Rodriguez

Art Unit

3625

Examiner

J. Zurita

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 52,161☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

SignatureEric S. Replogle

Typed or printed name

(408) 720-8300

Telephone number

August 10, 2005

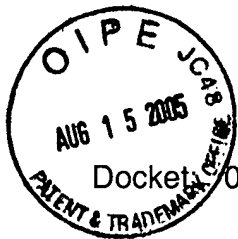
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 (one) forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



AF/3625
F. Wu

Docket: 006783.P011

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

John Rodriguez

Application No: 09/814,159

Filing Date: March 20, 2001

For: Media Asset Management
System

Examiner: James H. Zurita

Art Unit: 3625

Confirm. No. 2460

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action mailed on February, 22, 2005 and in concurrence with the Applicants' Notice of Appeal filed herewith, please consider the following remarks.

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on:

August 10, 2005

Date of Deposit

Cheri Clinkenbeard

(Typed or printed name of person mailing paper or fee)

Signature

August 10, 2005

Date

REMARKS

Applicant respectfully submits there is a clear legal deficiency in the current rejection because of Examiner's failure to use Applicant's own definition of the term "media gateway".

The Examiner rejected claims 1-4, 6-25, and 27-43 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 5,892,900 by Ginter et al. in view of alleged knowledge in the art and claims 5 and 26 under 35 U.S.C. §103(a) as being unpatentable over Ginter and Chui (U.S. Patent Number 6,657,702).

Ginter discloses methods and systems for digital rights management using secure subsystems. The secure subsystems provide a virtual distribution environment (VDE) that enforces a secure chain of handling and control across a network (Ginter, column 9, lines 19-32). An operating system on a device that implements VDE function has a "Rights Operating System" (ROS) (Ginter, column 18, lines 30-32). A component of the ROS is a gateway that translates remote procedure calls (RPC) into object switch calls and visa versa (Ginter, Figure 12, item 734; column 98, lines 56-60). The gateway described by Ginter enables the RPC manager to communicate with an element of the ROS that have an object switch interface (Ginter, column 98, lines 56-60).

To support his rejection the Examiner went beyond the literal teaching of Ginter and inferred that Ginter discloses another type of "gateway" because Ginter discloses multiple networks connected to Ginter's information utility (Ginter, Figure 1) and this, according to the Examiner, inherently discloses a gateway (Final Office Action, page 3). Please note that there is no explicit disclosure in Ginter of a "media gateway" as described and claimed in the present application.

Chui discloses encoding a recipient identifier in a photographic image where the identifier is used when re-ordering photographic prints. Furthermore, additional printing parameters are encoded in the photographic image. In addition, Chui does not teach or suggest a media gateway.

Claim 1 recites in part "... tracking information, at a media gateway, characterizing a particular media asset of interest that is uploaded to the media gateway associated with the data network, wherein the media gateway captures a plurality of media assets uploaded from a plurality of devices " Similarly, claim 22 recites in part "... a media gateway module for capturing uploading of a particular media asset of interest that is uploaded to the data network, wherein the media gateway module captures a plurality of media assets uploaded from a plurality of devices;..."

As supported in Applicant's specification, Applicants define a "media gateway" and "media gateway module" as is a device that "captures a plurality of media assets uploaded from a plurality of devices" and "tracking information, at [the] media gateway, characterizing a media asset". Applicants' media gateway is supported in the specification, for example at p. 5, lines 11-12 and p. 20, lines 4-8.

Applicants respectfully submit that Examiner fails to use Applicants' own definition for the term "media gateway." It is well known that "[a]n applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are given there ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meanings(s)." MPEP §2111.02, p. 2100-50. The patentee's ability to be his own lexicographer is further supported by case law ("... [the] specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Phillips v. AWH Corp.*, 2005 U.S. App. LEXIS 13954, *33-*34). It is respectfully submitted that Applicants clearly define a media gateway in the present application, pursuant to MPEP §2111.02, as a device that "captur[es] wireless and wireline uploads ... arriving from various devices" (Applicants' specification, p. 5, lines 11-12) and tracks information about the user session (e.g., user information, time of day photos were uploaded, how many photos uploaded, etc.; Applicants' specification, p. 20, lines 6-9). Further description of Applicant's media gateway is found in the U.S. Patent Application, Serial No. 09/759,108, incorporated by reference (see

Applicants' specification at p. 19, lines 23-25). Therefore, Applicants respectfully submit that Applicants have clearly set forth the definition of the term "media gateway" as it is claimed in the present application. Applicants made this same argument to the Examiner in a Response to an Office Action (Response filed April 22, 2005, page 12).

The Examiner has disregarded Applicants' definition of "media gateway", and instead insists on defining Applicant's "media gateway" as a general purpose "gateway" that "connects networks using different communication protocols so that information can be passed from one to another." (Final Office Action, mailed February 22, 2005, p. 15, lines 4-6).

It is respectfully submitted that the Examiner erred by disregarding Applicants' own definition of a "media gateway", and compounded this error by using a definition that does not encompass Applicants' definition. Applicants' **media gateway** as described and claimed in the present application tracks information about a media asset and captures uploads from various devices. The Examiner's **gateway** merely passes information from one network to another without tracking the information characterizing a media asset of interest as claimed. Thus, the Examiner's substituted definition actually teaches away from Applicants' intended special definition of "media gateway". Therefore, Applicants respectfully submit that the Examiner has incorrectly interpreted the term "media gateway" as used in Applicants' application, and this interpretation was the basis of an improper rejection.

Applicants respectfully submit that the term "media gateway" should not be given a meaning that is not intended and expressly provided by Applicants, and that the Examiner should in fact use Applicants' definition of "media gateway" in interpreting the scope of the claims. Even if Applicant's were to try to apply the Examiner's view of a "gateway", it would be difficult in view of the fact the Examiner himself has been inconsistent in his use of the term "gateway", from office action to office action. For example, the term "gateway" is explicitly used by Ginter to "enable the RPC manager to communicate with an element of the ROS that have an object switch interface." (Ginter, column 98, lines 56-60). In the August 14, 2004 Office Action, the Examiner used this "gateway" definition to reject Applicant's claims. In

contrast, in the final Office Action dated February 22, 2005, the Examiner suggests a different meaning of gateway that is inherent in the network disclosed by Ginter (Ginter, Figure 1). Because of the vague use of the term "gateway" demonstrated in the prior art, Applicant respectfully suggests that one of skill in the art would not readily recognize the term "gateway" as either of the definitions suggested by the Examiner, but rather would look to the Applicant's specification to determine how to properly interpret the term "media gateway" and its meaning within the application in order to practice the invention taught..

Accordingly, Applicants respectfully request that Examiner use Applicants' definition of "media gateway" when interpreting Applicants' claims 1-43.

Furthermore, because there is no teaching or suggestion in Ginter that teaches or suggests a media gateway as claimed, Applicants respectfully submit that claims 1 and 22, and claims 2-21, 23-43 that depend on them, are not obvious over Ginter. Therefore, Applicants respectfully request that the Examiner remove the rejection of claims 1-43 as being obvious over Ginter in view of alleged knowledge in the art.

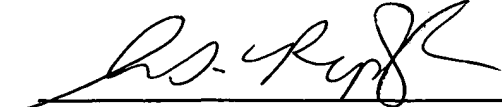
If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Eric Replogle at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 8/10/05


Eric Replogle
Reg. No. 52,161

Customer No. 003982
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(408) 720-8300